

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : **10/694,622** Confirmation No. **2614**
Patent No. : **7,561,536**
Applicant : **LARRY LEE ROUNDY, et al.**
Filed : **November 27, 2003**
TC/A.U. : **2614**
Examiner : **Quynh H. Nguyen**
Docket No. : **199-0065US**
Customer No. : **29855**
Title : **METHOD AND APPARATUS FOR SIMULTANEOUS INCOMING DIGITAL CALL
PROCESSING USING ISDN BONDING CHANNELS**

**SUPPLEMENTAL INFORMATION REGARDING REQUEST FOR
RECONSIDERATION OF PATENT TERM ADJUSTMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed to supplement a Petition filed 21 July 2009 and not yet decided. This supplemental Petition is being filed pursuant to a telephone conversation with PTO attorney Derrick Woods held on 11 January 2010. No fees are believed due in connection with this request. However, should any fees or refunds be due, the Office is authorized to charge or credit such fees or refunds to Deposit Account No. 501922, referencing attorney docket number 199-0065US.

Remarks begin on page 2 of this paper.

REMARKS

Applicants have received an issued Patent No. 7,561,536 which issued on July 14, 2009. The calculated Patent Term Adjustment (PTA) is 960 days. However, Applicants believe this case is entitled to a Patent Term Adjustment of 1631 days.

Applicants believe the PTA calculation should indicate 669 days of "A-Time" and 991 days of "B-Time" for the following reasons:

As currently codified, 35 U.S.C. § 154(b) provides three guarantees of patent term, two of which are at issue here. The first is found in subsection (b)(1)(A), the "[g]uarantee of prompt Patent and Trademark Office response." It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: fourteen months for a first office action; four months to respond to a reply; four months to issue a patent after the fee is paid; and the like. *See* 35 U.S.C. § 154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are called "A delays" or "A periods." The second provision is the "[g]uarantee of no more than 3-year application pendency." Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO.¹ *See* 35 U.S.C. § 154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the "B delay" or the "B period". ("C delays," delays resulting from interferences, secrecy orders, and appeals, are similarly treated but were not involved in the patent applications underlying this suit.)

Wyeth v. Dudas Civ. Action No. 1:07-cv-1492-JR, 2008 WL 4445642 D.D.C. affirmed in *Wyeth v. Kappos*, (Fed. Cir. 2010) decided 7 January 2001.

The pertinent dates for calculating the PTA for this case are as follows:

- 1) 10/27/2003 Application filing date;
- 2) 10/27/2006 Three years from filing (start of B time calculation);

- 3) 8/23/2007 Mailing date of first Office Action;
- 5) 7/14/2009 Issue date of Patent 7,561,536.

There are several categories of time calculation set forth in 37 C.F.R. 1.703 under subheadings a-g. The pertinent subheading in this instance are "a" (A-Time) and "b" (B-Time). Applicant notes that A-Time and B-Time are not allowed to overlap.

A-Time Calculation

The time period set forth under 37 C.F.R. 1.703(a), A-Time, allows fourteen months from the filing date for the Office to issue a first Office Action. The 14 month date in this case was 12/27/2004 and the first office action was not mailed until 8/23/2007. As noted above, A-Time and B-Time cannot overlap. Therefore, because the B-Time began accruing on 10/27/2006 the A-Time allocated before the first Office Action is calculated as the duration between 12/27/2004 (14 month date) and 10/27/2006 (B-time initiation). This duration is *669 days*. There are no other periods of A-Time to consider in this case because no Appeal Brief was filed and no Request for Continued Examination was filed so the B-time period, as explained below, never stopped accruing after it initiated.

B-Time Calculation

The time period set forth under 37 C.F.R. 1.703(b), B-Time, allows for 3 years pendency of an application. In the instant case, this is represented by the duration between 10/27/2006 (3 years from filing) and 7/14/2009 (Issue date of Patent). This time period represents 991 days. Therefore, the B-Time is *991 days*.

Applicant Delay Reconsideration

Furthermore, as previously stated in a Petition filed 21 July 2009, Applicants believe the patent should not have been assessed two (2) days of delay relative to the payment of the issue fee for the reasons set forth below.

The pertinent dates for reconsidering the PTA for this issue are as follows:

- 1) 3/6/2009 Mailing date of Notice of Allowance;
- 2) 6/8/2009 Issue Fee payment due date;
- 3) 6/8/2009 Issue Fee receipt;

The date 3 months after the mailing date of the Notice of Allowance is 6/6/2009, which was a Saturday. However, because this time period “ends on a Saturday, Sunday, or Federal holiday, the reply is timely if it is filed on the next succeeding business day.” M.P.E.P. § 710.01(a). Also, “when the day, or the last day, for taking any action or *paying any fee* in the United States Patent and Trademark Office falls on Saturday, Sunday or a Federal Holiday within the District of Columbia, the action may be taken, *or fee paid*, on the next succeeding secular or business day.” 35 U.S.C. § 21(b) (emphasis added). Further, “[t]he period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.” 35 U.S.C. § 154 (C)(i). Applicant’s assert that a timely filed response cannot constitute a failure “to engage in reasonable efforts.”

Additionally, the Notice of Allowance and Fees Due (attached in Appendix 1 of previously filed Petition dated 21 July 2009) clearly states that the Fees are Due on “06/08/2009.” Because, as shown in PAIR, the actual Issue Fee payment was received on its exact due date as defined by the Office and required by law under 35 U.S.C. § 21(b), it is unreasonable for the Office to assert that Applicant’s failed “to engage in reasonable efforts.” Therefore, Applicant’s respectfully request the PTA calculation be adjusted and reflect only 29 days of Applicant delay.

Sum of A-Time and B-Time per Wyeth

A-Time of 669 days plus B-Time of 991 days minus 29 days results in the correct calculation for PTA being *1631* days. Applicant respectfully requests that the PTA be adjusted to this number for the reasons stated above and request the Office to issue a Certificate of Correction for this Patent.

* * * * *

Respectfully submitted,

January 11, 2010

Date

/William M. Hubbard/

William M. Hubbard

Reg. No. 58,935

**WONG, CABELLO, LUTSCH,
RUTHERFORD & BRUCCULERI, L.L.P.**
20333 State Highway 249, Suite 600
Houston, TX 77070

832/446-2400

832/446-2424 (facsimile)

wcpatent@counselip.com